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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,261	06/25/2007	Karsten Duda	23709	6092
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KF ROSS PC 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900				
EXAMINER				
MARCO'ANTONI, PAUL D				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
05/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/590,261

Applicant(s)

DUDA, KARSTEN

Examiner

Paul Marcantoni

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

35 USC 112 Second Paragraph:

Claims 1-35 are rejected under the second paragraph of 35 USC 112 for failing to particularly point out and distinctly claim applicants' invention.

Consider amending all claims to using comprising claim language and deleting "characterized".

Claim 1 is indefinite as applicants do not particularly point out the specific carbonate compound in claim 1 which is critical for their drying and sealing properties. Consider adding the limitations of claim 5 (potassium carbonate) into claim 1 and all other independent claims (e.g. claim 18).

Claim 1 is also indefinite with respect to filling materials. It would appear not any filling material will lead to the sealing and drying properties critical to applicants' inventive composition. Consider canceling claim 8 and inserting the limitations of this claim into claims 1 and 18.

Claim 1 would appear vague since applicants use "mass%" in claim 1 and throughout the claims and specification. Please consider amending the entire disclosure and deleting mass% and replacing with wt% or weight%.

Claims 1-35 do not contain the article (A, An, or The). In claim 1, in the preamble, amend to --An agent--. In claims 2-8, --The agent--. In claim 9, --A method---. In claims 10-17, --The method---. In claim 18, --A method--. In claims 19-32, --The method--.

In claim 8, delete "or a mixture of these materials" and insert --mixtures thereof--.

In claims 1,9,18, the term "especially" is indefinite. Delete it.

In claim 9, delete "such as" before bricks and insert therefor --including--.

The terms "8 to 15 proportions" is vague in claim 9. Do applicants mean 8 to 15 parts water. Further, is this based on the filler material out of 100 parts of filler material? Clarification is requested including possible amendment.

Claims 12 and 21 are indefinite as it is unclear how this matching occurs.

Claims 14 and 23 are indefinite with respect to "a mixture of these". Amend to --or mixtures thereof--.

Claim 15 is indefinite. Do applicants mean --parts--water? Further, is it based on 100 parts of filler material. This is unclear if this is a breakdown of a composition within a composition. In other words, a breakdown of total parts by weight or total amounts of filler which includes water. The same is true for claim 17. Make the same corrections.

The term "especially" is indefinite in claim 18. Delete it.

The term "such as" is indefinite and can be replaced with --including--.

Claim 24 is indefinite as was claim 9, 15, and 17. Do applicants mean--parts water--? Also, address the same concerns made by examiner for claim 15. The same is true for claims 26-27. Proportions should be amended to --parts--.

Claim 28 is indefinite. What do applicants mean mineral colors hydrophobic? What is the material? How can a color which is just a description of the visual be hydrophobic?

Claim 31 is indefinite as it is unclear what "matched to one another encompasses".

Claims 33-35 are indefinite because "use of" claims are improper, indefinite, and also fail under 35 USC 101 as not a proper statutory class of invention. Amend to --A

method of using for independent claim 33 and make the dependent claims --The method of using according to----.

Claim 35 would appear indefinite. Do applicants mean mineral mixtures? Please amend all claims to correct that have the terms mineral colors if mineral mixtures is what is really meant.

35 USC 112 First Paragraph (Enablement):

Claims 1-35 are rejected under the first paragraph of 35 USC 112 as failing to provide an enabling disclosure and not commensurate in scope with applicants' enabling disclosure.

It would appear that undue experimentation beyond the level of ordinary skill in the art would be required to determine which specific carbonate and filling materials are critical to achieve applicants properties such as making hydrophobic and sealing. Applicants are referred to heading in Chapter 2100 (Patentability) under "Undue Experimentation" which includes undue experimentation factors or "Wands factors" (from In re Wands Case Law Decision) that necessitate this rejection.

This rejection can easily and immediately be overcome by inserting potassium carbonate into all independent claims (e.g. claim 1) and also inserting the specific fillers including those in claim 8 and mixtures thereof. Note that the examiner's search he found that this application was already allowed as a Europe Patent and these specific limitations would appear to be set forth in those independent claims.

It is expected that upon making these suggested amendments this application would be in immediate condition for allowance. No prior art was found close to instant

invention except for that within their own disclosure (See [0004] for DE 3804741 A1).

This German patent had similar components but not the same ones in the respective amounts claimed by applicants for their instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/
Primary Examiner, Art Unit 1793